

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of: ) Attorney Docket No.: F-278

John K. Eckl ) Group Art Unit: N/A

Serial No.: N/A ) Examiner: N/A

Filed: Concurrently herewith ) Date: July 12, 2001

Title: BILLING SYSTEM WITH ELECTRONIC AND PRINTED  
DISTRIBUTION

**PRELIMINARY AMENDMENT**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In response to the Office Action dated April 6, 2001, attached are:

- 1) Clean versions of an amendment to the specification and new claims  
12-36;
- 2) appropriate remarks;
- 3) a marked version of the specification to show changes.

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**CLEAN VERSION**

In the Specification:

*Title* -Please substitute the following new title:

BILLING SYSTEM WITH ELECTRONIC AND PRINTED DISTRIBUTION

*Reference to prior application-* Please add the following new sentence as a new paragraph in the first line of the specification after the title, and before "Background of the Invention":

This application is a continuation of U.S. Ser. No. 08/772,293 filed on December 23, 1996, entitled "Inserter Billing System With Electronic Distribution," now abandoned.

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In the claims:

Please cancel claims 1-11

Please add the following new claims 12-36.

12. A billing system for delivering billing statements from a biller to a recipient by means of a printed transmission or electronic transmission, comprising:

a billing server coupled to a biller's computer operative to receive billing information from said biller's computer and determine whether said billing information is intended for said printed transmission or said electronic transmission;

a printer operably connected to said server operative to generate a printed billing statement from said billing information;

an electronic information server operably connected to said billing server, said electronic information server operative to convert said billing information for electronic transmission and generate an electronic billing statement from said billing information and electronically transmit the electronic billing statement to the at least one recipient over a communications network; and

routing means coupled to said billing server for routing said billing information to said printer if said billing statement is determined to be transmitted by said printed transmission and to said electronic information server if said billing statement is determined to be transmitted by said electronic transmission.

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13. A billing system as recited in claim 12 further including a lookup table coupled to said billing server, said lookup table containing delivery preferences for the at least one recipient indicating whether a billing statement is to be transmitted by a said printed transmission or electronic transmission.

14. A billing system as recited in claim 12 wherein the biller's computer contains billing information for a plurality of recipients and the billing server includes means for separating billing information corresponding to individual recipients.

15. A billing system as recited in claim 12 further including an inserter system coupled to said printer.

16. A billing system as recited in claim 12 wherein the electronic information server includes means for determining whether or not a said recipient as retrieved a transmitted electronic billing statement.

17. A billing system as recited in claim 12 further including means for electronically transmitting funds from said at least one recipient to said biller.

18. A method for delivering billing statements from a biller to a recipient by means of a printed transmission or electronic transmission, comprising the steps of:

generate billing information for at least one recipient from a biller's computer;

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prescribing delivery preferences for said billing information;

associated said delivery preferences with said billing information to determine if said billing information is to be transmitted via printed transmission or electronic transmission;

generating a printed billing statement from said billing information if said billing information was determined to be transmitted via printed transmission;

converting said billing information for electronic transmission if said billing information was determined to be transmitted via electronic transmission; and

generating an electronic billing statement from said converted billing information if said billing information was determined to be transmitted via electronic transmission.

19. A method for delivering billing statements as recited in claim 18 further including the step of providing said delivery preferences in a database separate from said biller's computer for generating said billing information.

20. A method for delivering billing statements as recited in claim 18 further including the step of electronically transmitting funds from said at least one recipient to said biller.

21. In a billing system having a computer operative to generate billing information for a plurality of recipients and to communicate said billing information to a printer

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operative to generate printed billing statements from said billing information, an apparatus for delivering billing statements to the plurality of recipients by one of printed transmission or electronic transmission based upon a prescribed delivery preference of each said recipient, comprising:

means for accessing said billing information prior to said billing information being communicated to said printer, said billing information comprising a plurality of records, each record corresponding to one of said recipients and each said record not containing the prescribed delivery preference of the corresponding recipient;

means for isolating each said record from said billing information;

means for extracting from a database the prescribed delivery preference corresponding to each said isolated record;

means for determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon said extracted prescribed delivery preference;

means for converting billing information to a format appropriate for electronic transmission and generating an electronic billing statement from the billing information;

means for electronically transmitting said electronic billing statement to at least one of said recipients over a communications network; and

means for routing to said printer the records determined to be intended for printed transmission and to said converting and generating means the records determined to be intended for electronic transmission.

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22. An apparatus according to claim 21, wherein said prescribed delivery preferences are stored in said database prior to the generation of said billing information.

23. An apparatus according to claim 21, further comprising an inserter system coupled to said printer.

24. An apparatus according to claim 21, further comprising means for determining whether said recipients to whom electronic billing statements have been electronically transmitted have retrieved said electronic billing statements.

25. An apparatus according to claim 21, further comprising means for electronically transmitting funds from said recipients to a biller for whom said billing information is generated.

26. In a billing system having a computer operative to generate billing information for a plurality of recipients and to communicate said billing information to a printer operative to generate printed billing statements from said billing information, a method for delivering billing statements to the plurality of recipients by one of printed transmission or electronic transmission based upon a prescribed delivery preference of each said recipient, comprising:

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accessing said billing information prior to said billing information being communicated to said printer, said billing information comprising a plurality of records, each record corresponding to one of said recipients and each said record not containing the prescribed delivery preference of the corresponding recipient;

isolating each said record from said billing information;

extracting from a database the prescribed delivery preference corresponding to each said isolated record;

determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon said extracted prescribed delivery preference;

converting the records determined to be intended for electronic transmission to a format appropriate for electronic transmission and generating an electronic billing statement from the converted records;

electronically transmitting said electronic billing statements to the corresponding recipients over a communications network; and

routing to said printer the records determined to be intended for printed transmission.

27. A method according to claim 21, further comprising storing the prescribed delivery preferences in said database prior to the generation of said billing information.

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28. A method according to claim 21, further comprising determining whether said recipients to whom electronic billing statements have been electronically transmitted have retrieved said electronic billing statements.

29. A method according to claim 21, further comprising electronically transmitting funds from said recipients to a biller for whom said billing information is generated.

30. In a billing system having a computer operative to generate billing information for a plurality of recipients and to communicate said billing information to a printer operative to generate printed billing statements from said billing information, an apparatus for delivering billing statements to the plurality of recipients by one of printed transmission or electronic transmission based upon a prescribed delivery preference of each said recipient, comprising:

a switch for accessing said billing information prior to said billing information being communicated to said printer, said billing information comprising a plurality of records, each record corresponding to one of said recipients; and

a server coupled to said switch, said server comprising:

means for determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon the prescribed delivery preference of the corresponding recipient;

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means for converting billing information to a format appropriate for electronic transmission and generating an electronic billing statement from the billing information;

means for electronically transmitting said electronic billing statement to at least one of said recipients over a communications network; and

means for routing to said printer the records determined to be intended for printed transmission and to said converting and generating means the records determined to be intended for electronic transmission;

wherein said switch routes all of said records to said printer if said server fails or is taken out of service.

31. An apparatus according to claim 30, said server further comprising means for isolating each said record from said billing information.

32. An apparatus according to claim 31, said server further comprising means for extracting from a database the prescribed delivery preference corresponding to each said isolated record.

33. An apparatus according to claim 31, said server further comprising means for sanitizing each of said records.

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34. An apparatus according to claim 30, further comprising an inserter system coupled to said printer.

35. An apparatus according to claim 30, said server further comprising means for determining whether said recipients to whom electronic billing statements have been electronically transmitted have retrieved said electronic billing statements.

36. An apparatus according to claim 30, further comprising means for electronically transmitting funds from said recipients to a biller for whom said billing information is generated.

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**REMARKS**

It is requested that the above amendments be entered for the continuation application filed herewith. The present application is a continuation of U.S. Ser. No. 08/772,293 filed on December 23, 1996, entitled "Inserter Billing System With Electronic Distribution.

Claims 12-36, provided in this amendment, are currently pending in this application. Claims 1-11 are canceled. Claims 12-36 correspond to the claims with the same numbers previously submitted in the parent application.

In the parent application, claims of the same or similar scope were rejected under 35 U.S.C. § 103 based at least in part on U.S. Patent No. 5,802,498 to Comesanas ("Comesanas"). It appears that the Examiner considered Comesanas to be prior art under 35 U.S.C. § 102(e). Comesanas has a § 102(e) priority date of January 11, 1996.

It is respectfully submitted that Comesanas should not be considered prior art under 35 U.S.C. § 102(e) because the applicant invented the subject matter of the present invention prior to January 11, 1996. The applicant's prior invention, and the subsequent continuous activity leading to the filing of the patent application, is documented in the Declaration of Lawrence E. Sklar Under 37 C.F.R. 1.131, filed herewith. This documentation includes Exhibit A, a copy of the original invention disclosure papers created by the inventor, dated June 13, 1995.

Accordingly, the pending claims should not be rejected based on Comesanas. The pending claims are allowable over references in the Information Disclosure Statement filed herewith that may qualify as prior art.

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In view of the foregoing, it is respectfully submitted that the claims of this application are in a condition for allowance and favorable action thereon is requested.

Respectfully submitted,



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**Version with Markings to Show Changes Made**

In the specification:

*Title* -Please amend the title as follows:

~~INSERTER~~-BILLING SYSTEM WITH ELECTRONIC AND PRINTED DISTRIBUTION

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